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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91189629
Party	Defendant Multi Media Exposure, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD

-----	X	Opposition Proceeding
BORGHESE TRADEMARKS, INC.	:	No. 91189629
Plaintiff-Opposer,	:	Mark: PRINCE LORENZO
-- against --	:	BORGHESE'S LA DOLCE
	:	VITA
MULTI MEDIA EXPOSURE, INC..	:	Serial No. 77435171
Defendant-Applicant.	:	
-----	X	

APPLICANT'S MOTION FOR SUMMARY JUDGMENT

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APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Multi Media Exposure, Inc. (“Applicant”), applicant for registration on the Principal Register of the trademark PRINCE LORENZO BORGHESE’S LA DOLCE VITA, hereby moves for summary judgment, pursuant to 37 C.F.R. § 2.127(e) and Fed. R. Civ. Pro. Rule 56,¹ dismissing the claims of opposer Borghese Trademarks, Inc. (“Opposer”), purported owner of the trademarks BORGHESE and PRINCESS MARCELLA BORGHESE.²

INTRODUCTION

Applicant’s mark is named after a Lorenzo Borghese, a different person than Opposer’s Marcella Borghese. They share the same last name because, in fact, applicant’s principal Lorenzo is the grandson of Marcella (now deceased). Because she was descended from Italian nobility and wore the title “Princess”, he is similarly known as “Prince Lorenzo Borghese.” The marks are for substantially different goods: Opposer’s are used in connection with cosmetics, shampoos and conditioners (implicitly for use on people),³ and Applicant’s application is for use in connection with “pet shampoos, conditioners and body sprays” (for use on pets). As such, they are sold (or

¹ As required by 37 CFR § 2.127(e)(1), prior to filing this motion for summary judgment, Applicant duly provided its initial disclosures, pursuant to Federal Rules of Civil Procedure, Rule 26(a)(1) and 37 CFR § 2.120, as of July 17, 2009. Pursuant to 37 CFR § 2.127(d), discovery and all other proceedings not germane to this dispositive motion are suspended, pending the Board’s determination of this motion.

² For the sake of summary judgment, only, Applicant assumes that the chain of title, transferring the trademarks’ ownership from Marcella Borghese to Opposer, is complete and bona fide.

³ See PRINCESS MARCELLA BORGHESE, Reg’n No. 3369371 (“anti-aging cream ... shower and bath foam”), BORGHESE, Reg’n No. 1134398 and 3397006 (“perfume, cologne, after shave lotion, ...hair shampoo and conditioner”) and BORGHESE, Reg’n No. 3506702 (“retail store services in the field of cosmetics hair care preparations”).

intended to be sold) through different channels of trade, to different consumers, and there is no likelihood of confusion.

A. The Relevant Goods and Trade Channels Are Limited By the Description of Goods in the Respective Registration and Application.

The issue of likelihood of confusion must be determined based on the goods as they are set forth in the application and the cited registration. For example, absent a limitation in the registration, there is a presumption that goods travel in all channels of trade “suitable for *goods of that type*.” Guardian Products Company, Inc. v. Scott Paper Company, 200 U.S.P.Q. 738, 741, 1978 WL 21568 (T.T.A.B. 1978) (emphasis added). Absent restrictions as to classes of purchasers or trade channels, the Board presumes that goods recited in a registration “are or can be sold through all of the trade channels that can be utilized *for such goods*.” Warnaco Inc. v. Adventure Knits, Inc., 210 U.S.P.Q. 307, 315, 1981 WL 40431 (T.T.A.B. 1981) (emphasis added).

As set forth in more detail below, the goods in the application and registration are implicitly, if not expressly, so restricted. For example, the CCPA noted that because the multivitamins at issue were manufactured exclusively for human use, “the normal meaning” of the goods and services set forth in appellee’s application were “limited to human use”. Fort Dodge Labs., Inc. v. Haeussler, 43 C.C.P.A. 999, 1001, 234 F.2d 506, 508, 110 U.S.P.Q. 301 (C.C.P.A. 1956). Further,

The record shows that appellee's product has not been used or advertised for use to supplement the diet of animals and it could scarcely be used for that purpose without a complete revision of sales policy as well as a study to determine the kinds of animals for which it was adapted, and the dosage to be used.

Fort Dodge Labs, 43 C.C.P.A. at 1002, 234 F.2d at 509.

Likewise, Opposer's goods are for cosmetics, shampoo and other bath and body products, and as such the "normal meaning" is that they are for use by people, not pets. Indeed, Opposer admits that the goods are not marketed, and are not intended to be marketed, for use by pets. See Opposer's Supplemental Responses to Applicant's Interrogatories, dated September 8, 2009 ("Supp. Interrog. Resp."), annexed and made Exhibit A hereto, Nos. 4 and 5; Opposer's Responses to Applicant's Request for Production of Documents, dated September 8, 2009 ("Doc. Resp."), Nos. 2 and 3. In contrast, the application is expressly for "shampoos and conditioners *for pets*", and such goods are limited to end users who care for pets. Thus, the goods at issue herein are marketed to different consumers for different uses, specifically, those who use cosmetics, shampoos and bath and body products, and those who care for pets.

B. Factors for Determining Likelihood of Confusion

When testing for likelihood of confusion, the following factors when of record, must be considered, as set forth in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (CCPA 1973):

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark). (10) The market interface between applicant and the owner of a prior mark. (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e., whether *de minimis* or substantial. (13) Any other

established fact probative of the effect of use.

(1) Applicant's Mark and Opposer's Mark Are Dissimilar in Sound and Appearance

The marks, when considered in their entireties, are dissimilar and convey different commercial impressions. The Federal Circuit has held that where the marks do not present a similar sound, meaning, or commercial impression, there is no likelihood of confusion. For example:

The MAGNIVISION mark is a single word; the MAGNA• DOT mark consists of two words separated by a darkened circle. The MAGNIVISION mark has four syllables; the MAGNA• DOT mark has three. The MAGNIVISION mark displays eleven letters, the last seven of which do not appear in the MAGNA• DOT mark; the MAGNA• DOT mark has eight letters and a dot. The only similarity between the marks is the MAGNA/MAGNI prefix.

Al-Site Corp. v. VSI Intern., Inc., 174 F.3d 1308, 1330 (Fed. Cir. 1999).

Under a comparable analysis, Applicant's PRINCE LORENZO BORGHESE'S LA DOLCE VITA is patently different in sound and appearance from Opposer's BORGHESE and PRINCESS MARCELLA BORGHESE. Applicant's mark is six words; Opposer's marks are 1 word and 3 words. Applicant's mark has 12 syllables; Opposer's BORGHESE has 3 syllables, and PRINCESSA MARCELLA BORGHESE has 6 syllables. Applicant's mark has 33 letters and an apostrophe, 18 of which do not appear in Opposer's marks ("Lorenzo's" and "La Dolce Vita"); Opposer's marks have 8 letters, and 25 letters.

First, the major differences in sound and appearance between the marks at issue are significant enough to eliminate any likelihood of confusion. Indeed, the Board has found that relatively minor differences in sound and appearance are significant in connection with allowing registration of trademarks. See, e.g., In re Quadram Corp., 228

USPQ 863, 865 (T.T.A.B. 1985) (“while both marks are similar in that they share the common term “FAZER” or its phonetic equivalent “FASER,” applicant's mark “MICROFAZER” is specifically different in appearance and pronunciation from the cited mark.”); 7-Eleven Inc. v. Wechsler, 83 U.S.P.Q.2d 1715, 1725 (T.T.A.B. 2007) (“GULP” and “GULPY” were substantively dissimilar in sound and appearance; emphasis added).

In the case at hand, the commercial impression of Applicant’s mark is different from that of Opposer’s because (a) “Princess Marcella” clearly refers to a different person than “Prince Lorenzo”; (b) “Prince Lorenzo Borghese” is a more specific person than merely “Borghese” (as Opposer implicitly acknowledges, because Opposer uses both BORGHESE and PRINCESS MARCELLA BORGHESE; if BORGHESE were sufficiently specific, Opposer would not have sought to register and promote the other mark); and (c) “La Dolce Vita”, which translates into English as “The Sweet Life”, expressly conveys a sense of luxury and pampering (in this case, for the purchaser’s pets) not present in Opposer’s marks.

Moreover, surnames clearly are not protected upon mere adoption and use unless they have acquired secondary meaning. See In re McDonald's Corporation, 230 U.S.P.Q. 304 (T.T.A.B. 1986) (denying application to register MCDONALD’S for clothing items because “the relied-upon evidence of record relates to applicant's primary business of restaurants and food items obtained in said restaurants.”). See also In re Pirelli, 9 U.S.P.Q.2d 1564, 1988 WL 252329, *3 (T.T.A.B. 1988) (applicant relied on incontestable registrations for goods unrelated to the goods in connection with which it sought new registration; application for PIRELLI denied as primarily surname); In re Rogers, 53 U.S.P.Q.2d 1741, 1746-47 (T.T.A.B. 2000) (while applicant demonstrated

secondary meaning of surname GERSON for newsletter videotape, evidence was insufficient to prove acquired secondary meaning for printed publications, educational seminars, or tape recordings as set forth in application); In Re Marriott International, Inc., 2007 WL 4287245, *6 (T.T.A.B. 2007; not precedential) (despite allegation that MARRIOT is famous mark for hotels, it was primarily a surname, and had no secondary meaning for use in connection with charitable services; registration denied).

Thus, even assuming for the sake of summary judgment that Opposer has acquired secondary meaning in connection with goods and services Opposer sells (cosmetics, and bath and body products, for human use), Opposer has admitted that it has not sold, and does not intend to sell, products that are marketed for use on pets. Absent any secondary meaning that extends beyond the specific goods sold in connection with the mark, BORGHESE alone cannot be confusingly similar to Applicant's mark, especially because it is dramatically different in sound and appearance.

(2) The Goods Are Dissimilar

The goods as described in Applicant's application and Opposer's Registration, in connection with which Opposer's prior mark is in use, are substantially dissimilar.

Opposer has admitted that it has not sold, and does not intend to sell, any goods like Applicant's (shampoos and conditioners for use on pets). See Supp. Interrog. Resp. Nos. 4 and 5 (none of what Applicant has "advertised or promoted" are "directed or targeted for use on pets."); Doc. Resp. Nos. 2 and 3 (no responsive documents in response to request for materials promoting use of Opposer's goods for pets, or bona fide intent to sell any such goods).

Additionally, Opposer's only suggestion that shampoos and conditioners for pets are a "natural extension of the product line offered under Opposer's Marks" (Notice of Oppos. ¶ 14) is reference to a third party maker of shampoos and conditioners, rather than to any pet goods sold or intended to be sold by Opposer. See Supp. Interrog. Resp. No. 8. However, in contrast with such third party (the founder of PAUL MITCHELL hair products), Opposer admits that Opposer has no intent to provide goods or services intended for use for pets, specifically: "b) Opposer has not commenced planning for sale of its goods to pets; c) no such documents [concerning any intent to sell pet goods] exist at the present time."). Supp. Interrog. Resp. No. 11. Thus, there is no question that Opposer has not acquired secondary meaning in connection with pet goods – and does not intend to sell such goods.

Opposer alleges that some consumers use on their pets shampoos and conditioners that are made for human use, and that the possibility of such use on pets renders Applicant's mark confusingly similar to Opposer's. See Notice of Opposition ¶ 9. Specifically, Opposer avers that its "shampoo, conditioner, hair cleaning preparations, nail polish, shower and bath foam, shower gel, perfume, cologne, body and facial soaps [and] cleansers *could* be used on pets." Supp. Interrog. Resp. No. 3 (emphasis added).

Simply put, the possibility of consumers' engaging in unintended uses of goods or services – that is, a form of use for which the product is not designed -- simply cannot be a reasonable basis for determining a likelihood of confusion. Under Opposer's misguided logic, for example, if any consumers used Opposer's shampoos and conditioners on upholstery, or on carpets, Opposer would assert that any furniture or rug

shampoos that included the surname “Borghese” *could* be confusingly similar to Opposer’s line of cosmetics, bath and beauty products.

Opposer’s only allegation that its goods are similar to Applicant’s is that “goods of the type of Opposer’s are often used on pets.” Notice of Opposition, dated April 8, 2009 (“Opposition”), ¶ 9. See also Supp. Interrog. Resp. No. 6 (“Opposer notes that it is common knowledge that consumers use [such] products ... on or with pets.”) Opposer has declined to provide any examples – not a single anecdote -- of *Opposer’s* goods being used on pets. Id.

Rather, Opposer has stated that “Opposer’s products are intended to be used on anyone or *anything that might be appropriate.*” Supp. Interrog. Resp. No. 3 (emphasis added). However, as set forth in the annexed articles by veterinarians, the use of shampoos for people on pets (especially dogs) is likely to injure the animals, because human skin has a lower pH than dogs, and shampoos for humans are more likely to irritate dog skin. See Declaration of Lorenzo Borghese dated September 22, 2009 (“LB Declar.”), and Ex. C thereto. Thus, the use of Opposer’s products on pets is *not* appropriate and in fact can be harmful to pets.

Applicant respectfully submits that because the alleged use of Opposer’s goods or services are unintended and/or inappropriate, granting such opposition would improperly serve to protect such unintended or inappropriate use. Under Opposer’s logic, if it were “common knowledge” that consumers inappropriately used football helmets when skydiving, or used chemistry lab beakers for drinking beverages, then the owners of trademarks for football equipment and chemistry glassware could successfully oppose applications filed by skydiving services or dining glassware manufacturers. Surely, the

Lanham Act was not intended to create such results. See, e.g., Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd., 188 USPQ 517, 520 (T.T.A.B. 1975) (“The mere fact that the term ‘electronic’ can be used to describe any product that includes an electronic device does not make a television set similar to an electronic microscope, or an electronic automotive ignition system similar to telemetering devices.”) Thus, the opposition should be denied.

(3) The Established, Likely-to-Continue Trade Channels Are Dissimilar

Generally, goods that by their description are different are not likely to be confusingly similar, especially because they are sold to different consumer markets and in different trade channels. In this case, “Opposer’s goods are sold in department stores, spas, drug stores, pharmacies, and over the Internet.” Supp. Interrog. Resp. No. 10. In contrast, Applicant’s goods are intended to be sold in pet stores, on programs dedicated to pets on direct television (such as Home Shopping Network), and through web sites for pet goods. Applicant’s goods are not intended to be sold in spas (for people), department stores, drug stores, or pharmacies but even if they were, they would be in a section separate and apart from the pharmacy, beauty or bath and body products departments of any such general stores. See LB Declar., ¶ 3.

Indeed, the Board has found that there is no confusing similarity between trademarks used for pet goods and goods sold for human use, largely because of the different trade channels for such goods. In 7-Eleven Inc. v. Wechsler, 83 U.S.P.Q.2d 1715 (T.T.A.B. 2007), opposer alleged its extensive use and sales of soft drinks and other beverages in connection with its GULP trademarks. The Board found that opposer used its GULP marks in connection with fountain drinks sold in opposer's chain of

convenience stores, and in connection with candy, salads, and fruit. Applicant, however, used its GULPY mark in connection with a portable animal water dish. The Board noted that the goods at issue were substantially dissimilar:

Such disparate products would be bought under different circumstances and conditions and would not be encountered by the same persons under conditions likely to give rise to the mistaken belief that the products emanate from the same source.

In reaching this conclusion, we are aware that applicant's description of goods is unrestricted, and that its portable pet water dish could be sold anywhere such goods are normally sold. Nevertheless, while opposer sells pet foods, there is no evidence that it sells pet accessories (or that it intends to so expand its product line), that it has used its "Gulp" family of marks on anything other than human food and accessories therefor (*i.e.*, mugs and collectible cups), that any other company manufactures or sells fountain drinks or human food and pet foods or pet accessories under the same or confusingly similar trademarks. Based on the record before us, neither pet food, nor pet accessories, have ever been sold or promoted together with any of opposer's "Gulp" trademarks and, therefore, it cannot be said that recognition of the "Gulp" surname carries over to portable pet water dishes.

83 U.S.P.Q.2d at 1721.

Opposer in 7-Eleven argued that the channels of trade overlapped because applicant sold products in convenience stores and opposer sold pet products in convenience stores. However, the Board recognized “the products at issue are of such diverse nature and utilized for such different purposes that even if all of the products are sold in opposer's convenience stores, consumers would not believe that they emanate from a single source.” Indeed, “Even assuming that opposer sold applicant's products, opposer would make every effort to keep fountain drinks and pet accessories segregated because *no retailer would want consumers to associate fountain drinks and pet accessories.*” Id. at 1724 (emphasis added).

Other Board decisions indicate that pet goods and goods for human use travel in different trade channels. In Ricot, Inc. v. Becton, 56 U.S.P.Q.2d 1859 (T.T.A.B. 2000), the Board held that applicant's FIDO LAY (for edible dog treats) was a substantially different product when compared with opposer's FRITO LAY (for snack foods):

While both products are, generally speaking, food items, they are different in essential character: human snack foods vs. animal parts marketed as dog treats. The strongest evidence of a relationship between the goods is that there are at least two companies that make both dog food and human food. But there is no convincing evidence that dog food and human food products are marketed together.

56 U.S.P.Q.2d at 1861.⁴

In Bioglan Inc. v. Bioglan Laboratories, Inc., 44 U.S.P.Q.2d 1662, 1667, 1997 WL 732340 (C.D. Cal. 1997), the court held that plaintiffs' BIOGLAN marks for nutritional pet products was not confusingly similar to defendants' BIOGLAN PHARMA for psoriasis medicine intended for human use. Despite the virtually identical sound and spelling of the primary term of both marks, and that the function of both parties' products allegedly was to enhance healthy skin, "none of Plaintiffs' products is a human skin care product." Id. The court assumed that some large companies sold both nutritional supplements and prescription pharmaceuticals. However, there was no evidence of record that the nutritional pet products were sold in drug stores or other retail stores or marketed

⁴ In Ricot, upon weighing the fame of the opposer's mark, the similarity of the appearance and sound of the marks (only two letters' difference, with both marks including the word "Lay" and comprised of three syllables) and the inexpensive products allowing for impulse purchasing, the Board granted the opposition. However, those factors are distinguishable from the case at hand, because Opposer has not asserted in its Notice of Opposition that BORGHESE or PRINCESS MARCELLA BORGHESE are sufficiently "famous". Further, the marks at issue here are substantially different in appearance and sound – much more than FRITO LAY and FIDO LAY. Finally, Opposer's goods are relatively expensive, see LB Decl. Ex. E, rather than subject to the impulse purchase of a bag of corn chips.

to those who used or recommended defendants' products (for human use). The court noted that "Animal products have not generally been considered 'related' to human medications for trademark purposes." 44 U.S.P.Q.2d at 1669, citing Myers v. Polk Miller Prods. Corp., 40 C.C.P.A. 739, 745, 201 F.2d 373, 37-78, 96 U.S.P.Q. 233 (C.C.P.A. 1953) (worm medicine for dogs not related to dandruff treatment for humans); Mark Morris Assoc., Inc. v. Intercontinental Food Labs Co., 152 U.S.P.Q. 771, 772 (T.T.A.B. 1967) (meat and seafood condiment for humans not related to dog food); Fort Dodge Labs., Inc. v. Haeussler, 43 C.C.P.A. 999, 1001-02, 234 F.2d 506, 508, 110 U.S.P.Q. 301 (C.C.P.A. 1956) (multivitamins for humans not related to antiseptic and antiferment for veterinary use). See also M2 Software, Inc. v. M2 Communications, Inc., 450 F.3d 1378, 1384 (Fed. Cir. 2006) ("The unrelated nature of the parties' goods and their different purchasers and channels of trade are factors that weigh heavily against [registrant] M2 Software"); Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation, 954 F.2d 713, 719 (Fed. Cir. 1992) (parties' respective purchasers and potential purchasers are substantially different, and applicant's computer terminals and opposer's data processing services are different; likelihood of confusion for relevant persons not established).

Similarly, in Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 263, 84 U.S.P.Q.2d 1969 (4th Cir. 2007), the Fourth Circuit held that likelihood-of-confusion factors substantially favored defendant. The court noted that "Chewy Vuiton" toys for dogs are generally sold alongside other pet products, while plaintiff marketed its handbags as luxury items to be purchased only in its own stores or in special sections within department stores. As for the similarity of the goods themselves, "it is obvious that a "Chewy Vuiton" plush imitation handbag, which does not open and is manufactured as

a dog toy, is not a LOUIS VUITTON handbag sold by LVM.” 507 F.3d at 262. Louis Vuitton did not make pet chew toys; did not intend to do so in the future; and even if it so intended, “the products at issue are not similar in any relevant respect.” 507 F.3d at 263.

Thus, where two products are sold “to different classes of purchasers through different channels of trade,” there is minimal likelihood of confusion. See In re The W.W. Henry Company, L.P., 82 U.S.P.Q.2d 1213, 2007 WL 186661 (T.T.A.B. 2007) (PATCH 'N GO for chemical filler to repair polyolefin sold to plastic manufacturers, not confusingly similar to applicant's PATCH & GO for cement patch for drywall, concrete and the like, sold to do-it-yourselfers and contractors in hardware stores); Central Mfg. Co. v. Casablanca Indus. Inc., 87 Fed. Appx. 156, 159-60, 2003 WL 22977469 (Fed. Cir. 2004) (“no likelihood of confusion between the petitioners' use of the mark on products other than fans, such as bicycles and boats, and Hunter's use of the mark in connection with ceiling fans, because the products were dissimilar and were sold in different channels of trade.”). See also Checkpoint Systems, Inc. and Checkpoint Software Technologies, Inc., 269 F.3d 270, 289 (3rd Cir. 2001) (no likelihood of confusion where “products are advertised in different magazines and are promoted in entirely different trade shows” and sold to different consumers).

In the case at hand, the description of goods, alone, targets a particular consumer: those who care for pets. It is obvious from the description of goods and services alone that the consumer and channels of Applicant's pet goods are distinct from those of Opposer. Cf. Guardian Products Company, Inc. v. Scott Paper Company, 200 U.S.P.Q. 738, 741, 1978 WL 21568 (T.T.A.B. 1978); Warnaco Inc. v. Adventure Knits, Inc., 210 U.S.P.Q. 307, 315, 1981 WL 40431 (T.T.A.B. 1981).

It seems highly unlikely – and indeed, would be damaging to Opposer’s reputation among consumers of cosmetics, shampoos and other bath and body products – that Opposer would even attempt to sell its goods in pet stores. Indeed, Opposer has admitted that “Opposer’s goods are sold in department stores, spas, drug stores, pharmacies, and over the Internet.” Supp. Interrog. Resp. No. 10.

As for the Internet, GOOGLE searches for purchase of pet goods or products for humans like those sold by Opposer simply do not result in the same web sites. See LB Declar. ¶ 4 and Ex. D (GOOGLE searches for “shampoos” and “pet shampoos”, “hair conditioners” and “pet conditioners”); Gecko Trading Co., Inc. v. Gecko's Toes, Inc., 2009 WL 871662, *6 (T.T.A.B. 2009; not precedential) (“while both parties' goods are available over the Internet, the channels of trade therefor otherwise are distinct”). For example,

Respondent's software is also offered through the Internet, but we do not regard the fact that both parties' goods are offered through this medium as evidencing that they are sold through the same channels of trade. They are sold on different websites, with petitioner's collateral goods being sold through its own website, while spam-filtering software is not sold on this site.

Hormel Foods Corporation and Hormel Foods, LLC v. Spam Arrest, LLC, 2007 WL 4287254, * 12 (T.T.A.B. 2007; not precedential) (noting that opposer’s and applicant’s items “can be sold in a mass merchandise store like Wal-Mart, but there is no evidence that canned luncheon meat and email filtering software is sold together, or that people buying one item would come in contact with the other.”). See also In re Banom, Inc., 2008 WL 2271546, *5 (T.T.A.B. 2008; not precedential) (although websites on Internet sold protective gloves and boots, such goods and channels of trade were different enough to justify registration of applicant’s mark); In re Free-Flow Packaging International, Inc.,

2008 WL 4354152 (T.T.A.B. 2008; not precedential) (“shrink wrap film and air-filled cushioning, can be marketed together on the same Internet websites. However, these Internet websites fail to establish that the goods at issue here, i.e., the machines used to manufacture and dispense these end-products, are marketed in the same trade channels.”)

Where “there is not more than a theoretical possibility that [Applicant’s] goods would be purchased by general consumers at retail, we conclude that [the Board’s] ruling [of no likelihood of confusion] is proper.” PC Club v. Primex Technologies, Inc., 32 Fed. Appx. 576, 2002 WL 450076 (Fed. Cir. 2002). See Electronic Design & Sales, 954 F.2d at 717, citing Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc., 57 C.C.P.A. 804, 807, 418 F.2d 1403, 1405 (CCPA 1969) (“[w]e are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal”). See also In re Massey-Ferguson Inc., 222 USPQ 367, 368 (T.T.A.B. 1983) (“differences between the goods of the registrant and the services of the applicant are simply too great, even though the marks are almost identical, for confusion to be more than a remote possibility.”).

Thus, Opposer apparently suggests that its registration for shampoos and conditioners is not limited to “shampoos and conditioners for humans”, so that Opposer’s cosmetic products *might* be purchased by pet owner consumers for use on their pets. Assuming for the sake of summary judgment, only, that the marks at issue here were not substantially different, such a suggestion is “merely theoretical” and does not justify the opposition to registration. Rather, summary judgment should be granted to Applicant.

(4) Impulse Versus Careful Sophisticated Purchasing

The relevant goods are not subject to impulse purchasing. Opposer's shampoos sell for \$17.50 for an 8.4-ounce bottle, which is relatively more than most shampoos. See LB Decl. ¶ 5 and Ex. E-1 and E-2. The relatively high cost for Opposer's goods suggests that its consumers would not buy its products on impulse, but only after careful consideration and examination of the product. Further, consumers do not impulsively buy pet shampoo and conditioner for use on their own hair, but only make such a purchase upon visiting a pet store with the intent of caring for pets.

(5) The Fame of the Prior Mark

For purposes of summary judgment, only, Applicant assumes that Opposer's marks are relatively well-known in connection with cosmetics and bath and body products. However, Opposer has not asserted that its mark is "famous", and has admitted (as set forth below in connection with the ninth DuPont factor) that its marks have no secondary meaning for goods other than those set forth in its trademark registrations. Supp. Interrog. Resp. Nos. 9.

(6) The Number and Nature of Similar Marks Used on Similar Goods

Because the goods at issue – Applicant's pet shampoos, conditioners and body sprays, versus Opposer's shampoos and conditioners for people – are not similar, Applicant respectfully suggests that this factor is irrelevant.

(7) No Reported Actual Confusion

Opposer has confirmed that there are no instances of actual confusion. See Supp. Interrog. Resp. No. 12.

(8) No Concurrent Use

Because Applicant's mark is the subject of an intent to use application, solely for the purpose of summary judgment, Applicant respectfully suggests that this factor is not applicable. See also Supp. Interrog. Resp. No. 12 (not aware of any actual confusion).

(9) Opposer's Marks Are Not Part of a "Family" of Marks

Opposer has admitted that they do not have a "family" of marks that would encompass pet goods. See Supp. Interrog. Resp. No. 9 (in response to requesting details "for alleging that Opposer's Marks have acquired secondary meaning for (a) pet goods and (b) any other goods that are not set forth in the respective registrations for Opposer's Marks", Opposer responded, "Not alleged.>").

(10) There Is No Market Interface Between Applicant and Opposer

As set forth above, there is no market interface between Applicant and Opposer.

(11) Extent of Exclusive Right to Use the Mark: Applicant's Use of Both First Name and Surname Eliminates Any Likelihood of Confusion with the Surname, Alone

Both Opposer's and Applicant's marks incorporate the term "Borghese," which is primarily a surname. See, e.g., Borghese Decl. ¶ 6 and Ex. F (Encyclopedia Britannica article on the Borghese noble family; printout of first twenty "Borghese" names from www.WhoWhere.com, which indicates that there are at least 300 of such names throughout the U.S., alone and "Too Many Results" for a complete report). The surname of each of Applicant's principals is Borghese, including Lorenzo Borghese, whose first and last names are included in Applicant's mark. See Answer to Notice of Opposition, dated May 18, 2009 ("Answer"), ¶¶ 37. Lorenzo Borghese, in fact, is the grandson of "Princess Marcella Borghese" (now deceased), whose name comprises one of Opposer's marks.

Answer ¶¶ 38, 40.

Because BORGHESE is primarily a surname, the public will look to the many other portions of Applicant's PRINCE LORENZO BORGHESE'S LA DOLCE VITA in order to distinguish the source of goods from Opposer's. As a general matter,

[T]o prohibit an individual from using his true family surname is to 'take away his identity: without it he cannot make known who he is to those who with to deal with him; and that is so grievous an injury that courts will avoid imposing it, if they possibly can. . . . Speaking generally, when the defendant demonstrates a genuine desire to build a business under his own name, courts have been reluctant to proscribe all surname use whatever. . . .

Taylor Wine Company, Inc. v. Bully Hill Vineyards, Inc., 569 F.2d 731, 735, 196 U.S.P.Q. 593 (2nd Cir. 1978). In Taylor, the court fashioned an injunction against defendant's using TAYLOR alone in connection with wine, but allowed defendant, owned by the grandson of the plaintiff's founder, to include on the label a signature of his full name in order to distinguish his wine from plaintiff's. Taylor, 569 F.2d at 736.

Similarly, in M. Fabrikant & Sons, Ltd. v. Fabrikant Fine Diamonds, Inc., 17 F.Supp.2d 249, 255 (S.D.N.Y. 1996), the court enjoined Fabrikant Fine Diamonds from using the word "Fabrikant" in advertising unless a first name immediately preceded the last name "Fabrikant". See also Caesars World, Inc. v. Caesar's Palace, 490 F. Supp. 818, 829 (D.N.J. 1980) (enjoining beautician from doing business as "Caesar's Palace" or from using word "Caesar's," which was defendant's first name, except when followed by defendant's last name.)

Applicant acknowledges that the Board cannot grant the injunctive relief granted in the Taylor, Fabrikant and Caesar cases. However, PRINCE LORENZO BORGHESE'S LA DOLCE VITA already has the restriction, and distinguishing feature of a first name, imposed by the courts in those cases. Thus, any similarity in sound and

appearance, or any other purported confusing similarity, is readily eliminated by including both “Lorenzo” and “Borghese”.

(12) Potential Confusion is *De Minimis*

For the reasons set forth above, the potential confusion between the marks is *de minimis*.

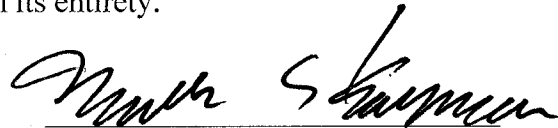
(13) No Additional Factors

For the purpose of summary judgment, only, Applicant does not believe there are any additional considerations impacting upon the likelihood of confusion analysis.

CONCLUSION

For the foregoing reasons, Applicant Multi Media Exposure, Inc. respectfully requests that the Board grant summary judgment to Applicant and dismiss the opposition of Opposer Borghese Trademarks, Inc., in its entirety.

Dated: New York, New York
September 23, 2009



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

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BORGHESE TRADEMARKS, INC.	:	Opposition Proceeding
	:	No. 91189629
Plaintiff-Opposer,	:	
	:	Mark: PRINCE LORENZO
-- against --	:	BORGHESE'S LA DOLCE
	:	VITA
MULTI MEDIA EXPOSURE, INC.	:	Serial No. 77435171
	:	
Defendant-Applicant	:	
-----		x

DECLARATION OF LORENZO BORGHESE

LORENZO BORGHESE declares the following to be true under penalties of perjury of the laws of the United States of America:

1. I am the Vice President of defendant-applicant Multi-Media Exposure, Inc. ("Applicant") and make this Declaration in support of Applicant's motion for summary judgment.

2. Applicant's pet shampoos and conditioners are most likely to be used on dogs, since other pets are less tolerant of being bathed. Opposer alleges that some people use regular shampoo (manufactured for human use) on pets, resulting in a likelihood of confusion between the marks at issue. However, using regular shampoos on pets, especially dogs, is likely to injure the animals, because human skin and dog skin have different pH levels; human skin is acidic while dog skin is alkaline. Dog's skin also is thinner and more sensitive than human skin. Further, dogs irritate their skin by scratching. (Articles from PetMD.com and veterinarians Foster and Smith are annexed and made Exhibit C hereto.)

3. Since November 2008, Applicant has sold its goods exclusively in pet

dedicated to pets on direct television (such as Home Shopping Network), and through web sites for pet goods. Applicant does not intend to sell its goods in spas (for people), department stores, drug stores, or pharmacies. Even if Applicant's goods were sold in such stores, pet goods would be in a section separate and apart from the pharmacy, beauty or bath and body products departments of any such stores.

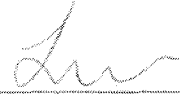
4. Although Applicant intends to sell its goods on the Internet, GOOGLE searches for pet goods or hair products for humans like those sold by Opposer simply do not result in the same web sites. (Copies of the first 20 "hits" from GOOGLE searches for "shampoos" and "pet shampoos", "hair conditioners" and "pet conditioners" are annexed and made Exhibit D hereto.)

5. The relevant goods are not subject to impulse purchasing. Opposer's shampoos sell for \$17.50 for an 8.4-ounce bottle, which is relatively more than most shampoos. (Copies of a web page from Bloomingdales' web site depicting Opposer's shampoo, and an article comparing the qualities and prices of 28 other shampoos, are annexed and made Exhibit E-1 and E-2 hereto, respectively.) Further, consumers do not impulsively buy pet shampoo and conditioner for use on their own hair, but only make such a purchase upon visiting a pet store with the intent of caring for pets.

6. Borghese is primarily a surname. (A copy of an article from Encyclopedia Britannica regarding the Borghese family is annexed and made Exhibit F hereto.)

WHEREFORE, Applicant Multi Media Exposure, Inc., respectfully requests that the Board grant summary judgment to Applicant and dismiss Opposer's opposition.

Dated: New York, New York
September 22, 2009



Lorenzo Borghese